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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/001,952 | 10/31/2001 | Stefan Vilsmeier | SCHWP0154US | 8866 |

7590 10/17/2005

RENNER, OTTO, BOISSELLE & SKLAR, LLP
1621 Euclid Avenue, Nineteenth Floor
Cleveland, OH 44115-2191

| EXAMINER |
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DAVIS, DANIEL J

| ART UNIT | PAPER NUMBER |
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3733

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/001,952 | Applicant(s) VILSMEIER ET AL. | |
| | Examiner D. Jacob Davis | Art Unit 3731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-16 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-16, 22, 23 and 25 is/are rejected.
- 7) ☒ Claim(s) 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-12, 14, 15 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,203,543 to Glossop. Glossop is interpreted in two ways. The first way is demonstrated in figure 1 of this Office action and reads on claims 1-3, 8-14 and 16-24. There is *substantially* no play between the securing element and the guide. The proximal threaded section of the securing element interacts with the groove.

Claims 1, 2, 6, 7, 14 and 15 read on the second interpretation of the device as demonstrated in figure 2D. The “operative section that is insertable into bone” does not recite a method step, but is a functional recitation. To meet the limitation, the device must be capable of performing the recitation. The “operative section” is fully *capable* of being inserted into bone.

Claims 22, 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,183,474 to Bramlet et al. As illustrated in figure 2, Bramlet discloses an operative section 22 having external threads, and an axially extending groove comprising the exit slit of a removable securing element 60 (which may be removed from the bone),

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,719,757 to Neubauer et al. in view of Glossop. Neubauer discloses a fixing device comprising an operative section 43 and 45 and a head 44. The operative section includes a guide since it guides the tongs 43.

Neubauer fails to disclose that the operative section or tongs may be screwed into bone. Glossop teaches threaded fasteners to be inserted into bone. It would have been obvious to one of ordinary skill in the art at the time the invention was made to thread the operative section 43 to more securely fasten the device to bone.

Further there is an intermediate section comprising a shaft between the head and the operative section, which has a larger diameter than the operative section. Regarding claim 9, the tips of tongs 43 are tapered. The device comprises a connecting element comprising the arm that receives the positioning member. The positioning element 41 is fixed to the fixing system 43, 44, and 45 by an adjusting device 48.

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Allowable Subject Matter

Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed September 14, 2005 have been fully considered but they are not persuasive. The Glossop reference discloses an operative section that may be screwed into bone as explained.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (571) 272-4693. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

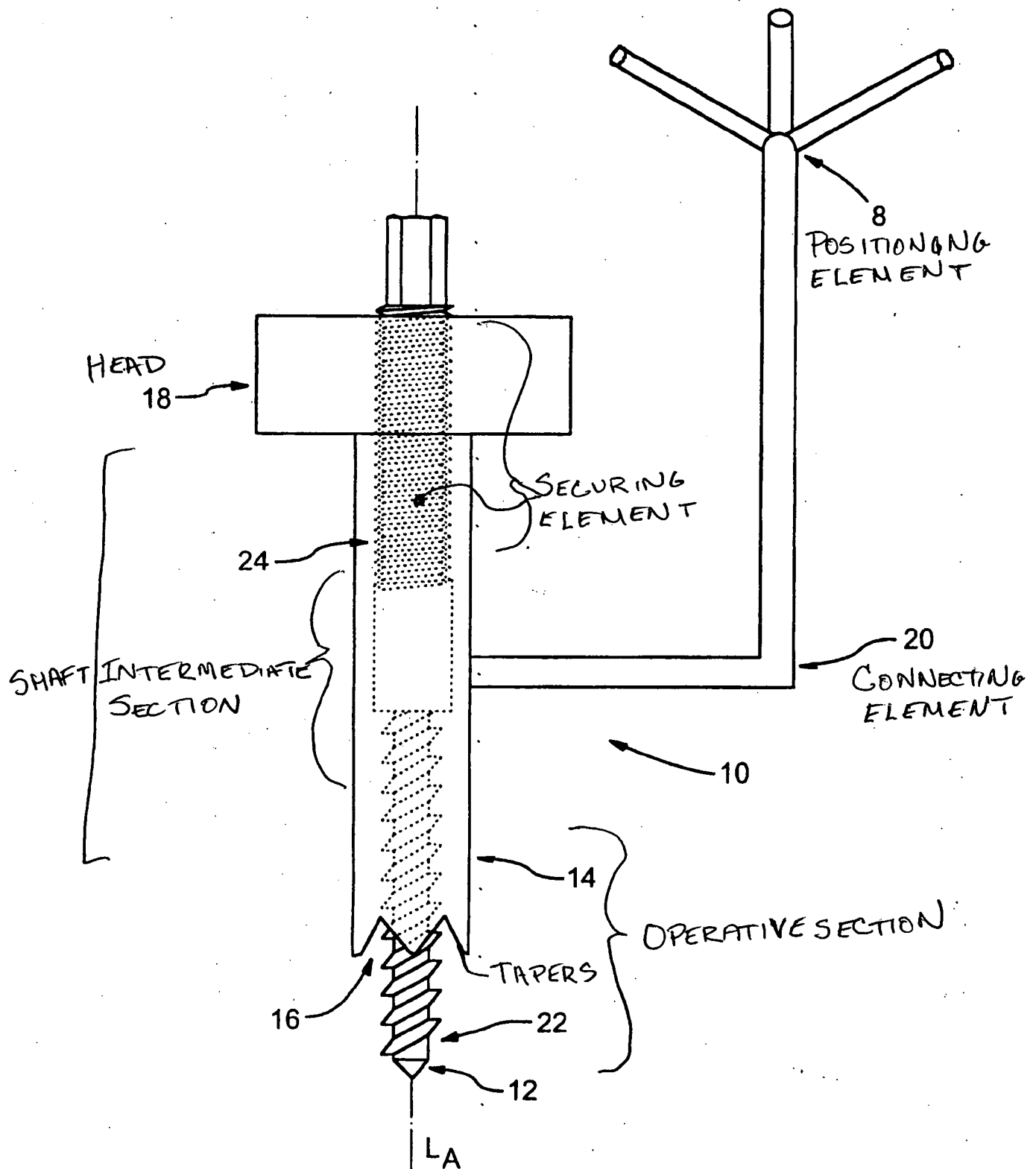
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJD

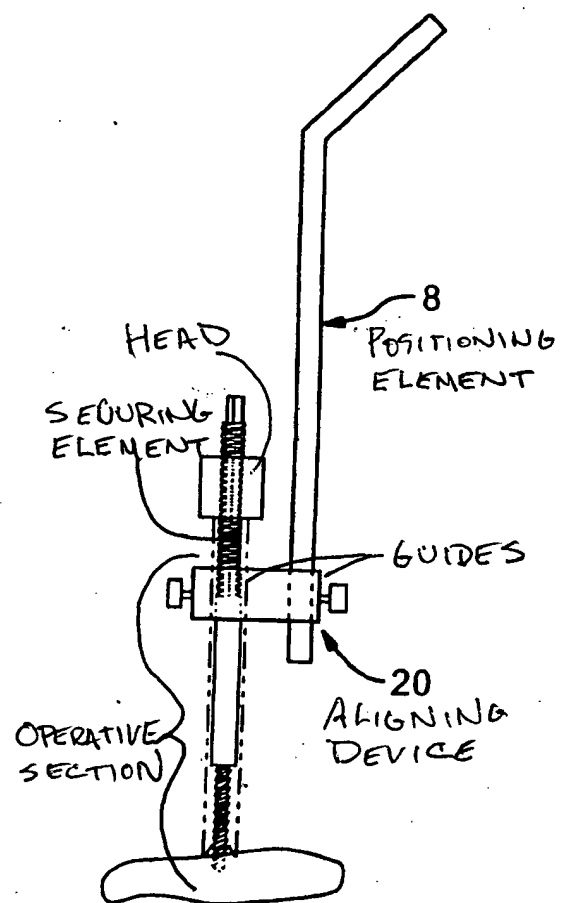


EDUARDO C. ROBERT
PRIMARY EXAMINER



GLOSSOP, FIG. 1

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GLOSSOP, FIG.2D